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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,317	02/08/2001	Tsuguhide Sakata	1232-4681	4553
27123	7590	11/14/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			RAMAKRISHNAIAH, MELUR	
			ART UNIT	PAPER NUMBER
			2643	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/779,317	Applicant(s) SAKATA, TSUGUHIDE	
	Examiner Melur Ramakrishnaiah	Art Unit 2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 7-10, 13-15, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapp et al. (US PAT: 6,073,192, filed 2-5-1996, hereinafter Clapp) in view of Shibata et al. (JP07-254960, hereinafter Shibata).

Regarding claim 1, Clapp discloses communication device for communicating in video and audio with other terminal device, comprising: an external connection interface (142, fig. 5) for connecting with an external processor (72, fig. 5), communication means (170, fig. 5) for exchanging information with the other terminal device as shown in fig. 7, control means (200, fig. 5) that operates in accordance through operation means and outputs video to be displayed to the video output means (76, fig. 5) in the first operation modes (this reads on conferencing using local monitor, col. 7 lines 17-29), and operates in accordance with the control commands from the external data processor (72, fig. 5; 244, fig. 7) through the external connection interface (for example 250, fig. 7) and transfer video data to be displayed in the second operation mode, wherein in the second operation mode, the control commands are generated by an application program running in the external data processor (72, fig. 5; 244, fig. 7; col. 9 lines 33-48).

Regarding claims 7, Clapp discloses a control method of a communication device for communicating in video and audio with other terminal device, the communication

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device having a first operation mode (this reads on conferencing using local monitor, col. 7 lines 17-29), in which the communication device operates on the basis of an operation through its own communication means and a second operation mode in which the communication device operates under the control of an external data processor, the method comprising: a first operation step for operating the communication device in accordance with an operation through the operation means (200, fig. 5) with the operation mode when the first operation mode is set, a display output step for outputting video to be displayed to a video output device (76, fig. 5) provided in the communication device (col. 7 lines 17-29), a second operation step (this reads on displaying audio and video on computer monitor 74, fig. 5) for operating the communication device in accordance with control commands from the external data processor (72, fig. 5; 244, fig. 7) wherein second mode is set in the operating mode setting step, transfer step for transferring video data to be displayed to the external data processor, and wherein the second operation mode, the control commands are generated by an application program running in the external data processor (72, fig. 5; 244, fig. 7, col. 9 lines 33-48; col. 16, line 51 – col. 17, line 32).

Clapp differs from claims 1, 7 in that he does not explicitly teach the following: mode setting means for setting a first operation mode for unassisted operation or a second operation mode for operation under control of external data processor, inhibition means for inhibiting change from the first operation mode to the second operation mode or change from the second operation mode to the first operation mode, while communicating with other device.

However, Shibata teaches the following: mode setting means for setting a first operation mode for unassisted operation or a second operation mode for operation under control of external data processor, inhibition means for inhibiting change from the first operation mode to the second operation mode or change from the second operation mode to the first operation mode, while communicating with other device (Drawing: 1, abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Clapp's system to provide for the following: mode setting means for setting a first operation mode for unassisted operation or a second operation mode for operation under control of external data processor, inhibition means for inhibiting change from the first operation mode to the second operation mode or change from the second operation mode to the first operation mode, while communicating with other device as this arrangement would provide means for setting mode of operation of the communication device to suite application needs of the user as taught by Shibata, thus enhancing user convenience.

Regarding claims 2-3, Clapp teaches communication device provides stand-alone video conferencing capability such that the communication device is automatically operating in the first operation mode after power is supplied (col. 7 lines 17-29 and col. 16 lines 19-50), and the communication device is operating in the second operation mode in accordance with a control instruction with the external processor when the communication device is coupled with an external processor (col. 7 lines 30-49, col. 16 lines 51-66). Thus, it recognizes the mode setting means set the first operation mode in

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response to the connection state with the external processor changing to a substantially disconnected state.

Regarding claim 4, Clapp teaches the communication device capable operating in accordance with a control signal from the external processor (col. 7 lines 30-35).

Regarding claims 8-9, the limitations of claims are rejected for the same reasons as set forth in claims 2-3.

Regarding claim 10, the limitations of the claim are rejected for the same reasons as set forth in claim 4.

Regarding claim 18, the limitations of claims are rejected for the same reasons as set forth in claims 1 and 7.

Regarding claim 13, Clapp teaches the following: in the first mode , control means makes a control such that video data to be displayed are output to the video output means (76, fig. 5) and the control means (200, fig. 5) executes predetermined operation in accordance with pieces of operation information from the operation means and pieces of operation information from the external data processor (col. 7 lines 18-29) and, in the second mode, the control means transfers video data to be displayed to the external data processor (72, fig. 5; 244, fig. 7) through the external connection interface (142, fig. 5; 250, fig. 7) to display the video data on a display device provided of the external data processor and receives control information based on operation to operation means provided for the external data processor through the external connection interface means and control it to operate in accordance with the control means (col. 7 lines 30-49; col. 9 lines 33-48; col. 17, line 62 – col. 18, line 26).

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3. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapp in view of Shibata as applied to claims 1 and 7 above, and further in view of Chivers (US PAT: 4,376,973).

The combination differs from claims 14-17 in that it does not explicitly teach the following: transition of the second operation mode to the first operation mode is made automatically when the application program is terminated during the operation of the external data processor in the second operation mode. However, it is old and notoriously well known in the art of a processor capable of switching from a first operation mode to a second operation mode when the execution program is completed in order to improve an operability of the processor by automatically switching from one operation mode to another operation mode when the program execution is completed, for example see Chivers (col. 1 lines 50-57). Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination in having the transition of the second operation mode to the first operation mode is made automatically when the application program is terminated during the operation of the external data processor in the second operation mode, as per teaching of Chivers, in order to improve operability of the processor by automatically switching between different operation modes when the program is completed.

4. Claims 5-6, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clapp in view of Shibata as applied to claims 1 and 7 above, and further in view of Kato et al. (US PAT: 5898,894, hereinafter Kato).

Regarding claims 5-6, the combination teaches the following: communication device comprising a recording medium (col. 8 line 25 of '192); but it does not teach the following: recording management means for recording data to be recording in an external data processor when the recording medium has its space area less than a predetermined amount, and recording management information indicating that the data is recorded in the external processor on the recording medium, wherein the management means checks on the basis of the management information as to whether or not data to be reproduced exists in the recording medium when it exists in the recording medium and request the external data processor to transfer the data when it exists in the external data processor.

However, Kato teaches a method to improve a storage capacity of a communication device, i.e., a facsimile device, connected with a computer comprising detecting means, i.e., management means, for checking the residual amount of storage capacity of a first storage in the communication device, selecting a second storage device in the computer for storing data when detecting means detecting that first storage space has space area less than a predetermined amount, and means for determining whether the data is stored in the first storage or the second storage in order to reproduce the data being stored in the second storage when it exists in the computer (col. 10, line 50 – col. 14, line 67) so that it recognizes the detecting means recording management information indicating that the data is recorded either in the communication device or the computer.

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Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination in having the management means, as per teaching of Kato, as it improves the storage capacity of the communication device.

Regarding claims 11-12, the limitations of the claims are rejected for the same reasons as set forth in claims 5-6.

Response to Arguments

5. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melur Ramakrishnaiah
Primary Examiner
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